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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,744	12/11/2001	Raymond P. Johnston	54404US009	7941

32692 7590 06/24/2003

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EXAMINER

LEWIS, KIM M

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 06/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

**Office Action Summary**

Application No.

10/016,744

Applicant(s)

JOHNSTON ET AL.

Examiner

Kim M. Lewis

Art Unit

3761

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed papers filed 4/15/02 has been received and made of record in the application file wrapper. The IDS has been acknowledged, note the attached PT0-1449 form.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-9 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 16, 19-22, 26, 34 and 37 of U.S. Patent No. 6,420,622 ("the '622 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely broader in scope. Thus the patented claims anticipate the applications claims.

As regards claim 12, the '622 patent fails to teach the type of medicament. However, claim 39 of the '622 patent recites "...while reducing the influx of microbial contaminants into the medical treatment site." Such a recitation alludes to the fact that an antimicrobial medicament may be used. As such, one having ordinary skill in the art would have been motivated to use an antimicrobial medicament in order to bring about such a reduction in microbial contaminants.

4. Claims 10 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 37 of the '622 patent in view of U.S. Patent No. 5,514,120 ("Johnston et al.").

As regards claim 10, the '622 patent fails to teach a plurality of films. However, as can be seen in the embodiment of Fig. 5, Johnston et al. disclose a plurality of films (512) for distributing fluid in order to aid in directional spreading of the fluid.

In view of Johnston et al, it would have been obvious to provide the article of the '622 patent with a plurality of films in order to aid in directional spreading of the medicament.

As regards claim 11, the '622 patent fails to teach that fluid transfer is orthogonal to the plane of the micro-structure bearing surface. However, as can be seen in Fig. 8 of the Johnston et al. patent, the channel has a right angle. Additionally, col. 3, lines, 58-60 states that fluid transporting occurs along the axis of the channels. Therefore, fluid transfer is orthogonal in the embodiment of Fig. 8.

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In view of Johnston et al., it would have been an obvious design choice to one having ordinary skill in the art to modify the '622 patent to include channels having various designs so as to transfer fluid in various ways and directions.

Additionally, absent a critical teaching and/or a showing of unexpected results derived from the angle of fluid transfer, the examiner contends that such an angle is an obvious design choice, which does not patentably distinguish applicant's invention.

### ***Conclusion***

5. The following prior art made of record and not relied upon shows the state of the art: U.S. Patent No. 6,290,685 issued to Insley et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays and Tuesdays from 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703.308.1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.3590 for regular communications and 703.305.3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0858.

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**Kim M. Lewis**  
**Primary Examiner**  
**Art Unit 3761**

kml  
June 14, 2003